

**REMARKS**

This Request for Continued Examination is in reply to the Final Office Action of May 5, 2008. Therefore, the time period for reply extends up to and includes August 5, 2008. Applicants wish to thank the Examiner for careful review and consideration of the present application.

Claims 3, 4, 5, 24 and 25 have been amended. Claims 26 and 27 have been withdrawn – presently amended and claims 28 – 32 have been amended (all without prejudice or disclaimer). Claims 3 – 11, 13 – 16 and 22 – 34 are pending. New Claims 33 and 34 have been added. No new matter has been added and support for the amended claims can be found in the original specification or claims, at least at page 4, lines 13 – 17, page 26, Glossary and page 5, lines 12 – 18 .

**First Consideration**

The Office Action asserts that claims 26 – 32 are directed to an invention that is independent or distinct from the invention originally claimed. Applicants respectfully traverse this assertion.

Applicants have withdrawn, with amendment, claims 26 and 27 and have withdrawn claims 28 – 32 without prejudice or disclaimer. Composition claims 26 – 32 do contain isocyanate groups (component iii) that can react with components (i) and (ii). Therefore, it would not be unduly burdensome for the Examiner to search this family of claims 26 - 32 together with the subject matter of claims 3 – 11, 13 – 16 and 22 – 25. Applicants respectfully request rejoinder of claims 26 – 32 for prosecution in the present application.

**Rejections Under 35 U.S.C. § 112**

The Office Action asserts that claims 3 – 11, 13 – 16 and 22 – 25 are rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

Independent claims 24 and 25 have been amended to include R1 and R2 being hydroxyalkyl and dihydroxyalkyl. Support for this amendment can be found at least at page 4, lines 13 – 17, and page 26, Glossary. Applicants submit that the amendment overcomes the rejection asserted in the Office Action and puts claims 24 and 25 in condition for allowance.

The Office Action asserts that claim 5 is rejected under 35 U.S.C. 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully traverse the rejection.

Applicants remain unclear as to the rejection of claim 5. However, to advance prosecution of the application, applicants have amended claim 5, without prejudice or disclaimer, to clarify weight percentages of component (a) and component (b). Support for the amendment to claim 5 can be found at least at page 5, lines 12 – 18.

In view of the foregoing, reconsideration and withdrawal of the § 112 rejections is requested. Applicants do not otherwise concede the correctness of the rejections and reserves the right to make additional arguments as may be necessary.

#### **Nonstatutory Double Patenting**

The Office Action asserts that claims 3 – 11, 13 – 16 and 22 – 25 are provisionally rejected based on nonstatutory obviousness-type double patenting. Applicants may provide a terminal disclaimer, if appropriate, once one of the applications in question has issued, and the rejection is no longer provisional.

#### **Rejections Under 35 U.S.C. § 102**

Claims 5 – 11, 13 – 16 and 22 – 25 are rejected under 102(e) as being anticipated by Moore et al. (6,649,272). Applicants respectfully traverse the rejection.

The '272 patent is derived from the inventor of this application and is not the invention by "another." Applicants submit that the § 102(e) rejection is now moot.

Claims 5 – 11, 13 – 16 and 22 – 25 are rejected under 102(b) as being anticipated by WO 02/30848. Applicants respectfully traverse the rejection for at least the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. In view of current claim amendments, WO 02/30848 does not disclose each and every claim element of the present application.

Independent claim 24 and 25 recite T and T' each independently representing -CO<sub>2</sub>R<sup>3</sup>, where R<sup>3</sup> is hydrogen or hydroxyalkyl, or -C(O)N(R<sup>1</sup>)(R<sup>2</sup>), where R<sup>1</sup> and R<sup>2</sup> are independently hydrogen, hydroxyalkyl, dihydroxyalkyl or polyalkylenepolyamine. In stark contrast, WO 02/3048 recites compositions which contain urethane linkages between the R<sub>f</sub> group and the silane group. Table 2, Example 15 on page 17 of the WO 02/30848 exemplifies this. The amendments to the specification recited above now reflect the correct reference to the Example of WO 02/30848. Applicants wish to thank the Examiner for pointing out this inconsistency. Data of Comparative Example C1 of the present application results from a composition containing a urethane linkage. These linkages do not exhibit as good of base stability as the linkages of claims 24 and 25: -CO<sub>2</sub>R<sup>3</sup>, where R<sup>3</sup> is hydrogen or hydroxyalkyl, or -C(O)N(R<sup>1</sup>)(R<sup>2</sup>), where R<sup>1</sup> and R<sup>2</sup> are independently hydrogen, hydroxyalkyl, dihydroxyalkyl or polyalkylenepolyamine.

In view of the foregoing, reconsideration and withdrawal of the § 102 rejections is requested. Applicants do not otherwise concede the correctness of the rejections and reserve the right to make additional arguments as may be necessary.

### **Rejections Under 35 U.S.C. § 103**

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being obvious over Moore et al. ('272) or WO 02/30848, each in view of Brown (6,495,624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

**Moore et al.**

The arguments and remarks provided above for rejection of claims 5 – 11, 13 – 16 and 22 – 25 rejected under 102(c) as being anticipated by Moore et al. (6,649,272) are also fully relevant here and are incorporated by reference to avoid repetition. Because the Moore et al. reference has been removed by declaration under 37 C.F.R. 1.132, Applicants submit that the § 103(a) rejection is now moot.

#### **WO 02/30848**

The arguments and remarks provided above for rejection of claims 5 – 11, 13 – 16 and 22 – 25 rejected under 102(b) are also fully relevant here and are incorporated by reference to avoid repetition. The '848 publication fails to teach or suggest the linkages as described above compared with the elements of the claims of the present application. Neither Brown (6,495,624), Scicchitano et al. (US 2002/0016267) nor WO 01/34670 remedy this deficiency. Therefore, the claims of the present application are not obvious under 35 U.S.C. § 103(a) for WO 02/30848, in view of Brown (6,495,624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

In light of the foregoing, reconsideration and withdrawal of the § 103(a) rejections is requested. Applicants do not otherwise concede the correctness of the rejections and reserve the right to make additional arguments as may be necessary.

#### **Conclusion**

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance.

Respectfully submitted,

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